APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,664	07/12/2001	Jin Soo Lee	24286/81101	2101

37803   7590   06/30/2008
SIDLEY AUSTIN LLP
555 CALIFORNIA STREET
SUITE 2000
SAN FRANCISCO, CA 94104-1715

EXAMINER
PATEL, DHAIRYA A

ART UNIT	PAPER NUMBER
2151	

MAIL DATE	DELIVERY MODE
06/30/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/902,664	LEE ET AL.
	Examiner	Art Unit	
	Dhairya A. Patel	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>18 June 2008</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>80-84,87-92,94-99,102-107,109-114,117-122,124 and 125</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>80-84,87-92,94-99,102-107,109-114,117-122,124 and 125</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to RCE communication filed on 6/16/2008. Claims -

   84,87-92, 94-99, 102-107, 109-114, 117-122, 124-125 are presented for

   examination. Claims 24-79, 85,86, 93, 100, 101, 108, 115, 116, 123 are

   cancelled. Claims 1-23 are withdrawn from consideration.

2. This amendment has been fully considered and entered.

Continued Examination Under 37 CFR 1.114

   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

6/16/2008 has been entered.

Double Patenting

   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 80,111,96 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,27,42 respectively of copending Application No. 11/365,208. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite similar limitations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 80-84,87-92, 94-99, 102-107, 109-114, 117-122, 124-125 are rejected under 35 U.S.C. 102(b) as being anticipated by Lawler et al. U.S. Patent # 5,758,259 (hereinafter Lawler)

As per claim 80, Lawler teaches a method implemented by an apparatus for processing information related to consumption of multimedia content, the method comprising:

-receiving one or more group descriptions ("personal preference" or "household preference" or "national preference" or "critics preference") ***from a server about digital broadcast*** (column 3 lines 24-31, column 11 lines 3-31), each of the one or more group descriptions describing actual content elements common in each member of a respective group of multimedia objects ("Kung Fu: The legend continues" or "Trailside: Make you" or "My fair lady" or "star wars"), and including a title for the respective group and a group identifier (table 1a "movie criteria" or "sports criteria") that is a distinct element of the group description and identifies the respective group of multimedia objects (television series "MASH" Table 1c) (column 6 lines 36-42) (Fig. 3A-C)(column 4 lines 43-57)(column 5 lines 20-51)

-storing the group identifier and at least a portion of each of the one or more group descriptions in the apparatus (column 7 lines 58-67)(column 8 lines 1-3, lines 34-44)(Table 2) ;

-receiving a first content description and a first group description from the server, the first content description describing content in a first multimedia object and including (i) a title for the first multimedia object (Table 1a, "director"), (ii) a first object identifier that identifies the first multimedia object (Table 1a "George Lucas"), and (iii) a first group reference that includes a first group identifier to identify a first group of multimedia objects to which the first multimedia object belongs (Table 1a "movie criteria"), wherein the first group description describes actual content elements common in each member of the first group of multimedia objects and includes at least a title for the first group of multimedia objects (column 6 lines 10-67)(column 7 lines 1-34);

-comparing the first group identifier with the group identifier of each respective group of the one or more previously stored group descriptions if the first multimedia object is displayed on a terminal of the apparatus (column 7 lines 35-61); and

-if the first group identifier is different from the previously stored group identifiers, storing in the apparatus the first group identifier and at least a portion of the first group description about the actual content elements common in each member of the first group of multimedia objects (column 8 lines 51-67)(column 9 lines 1-10).

As per claim 81, Lawler teaches the method of claim 80, further comprising:

-storage a usage history that lists user actions and associates the first object identifier with each user action that is related to the first multimedia object (Fig. 6)(column 8 lines 51-67)(column 9 lines 1-11).

As per claim 82, Lawler teaches the method of claim 81, further comprising:

-providing first link information in the usage history, wherein the first link information is configured to link the first group description to each user action that is related to the first multimedia object and listed in the usage history (Fig. 6)(column 8 lines 51-67)(column 9 lines 1-11).

As per claim 83, Lawler teaches the method of claim 82, wherein the first link information includes the first group identifier (column 9 lines 2-11 "Talk show criteria")

As per claim 84, Lawler teaches the method of claim 81, wherein storing the usage history includes storing the usage history with the first link information, but without storing the received first group description if the first group identifier is the same

as one of the previously stored group identifiers (Fig. 6)(column 8 lines 51-67)(column 9 lines 1-11).

As per claim 87, Lawler teaches the method of claim 80, wherein the first group of multimedia objects represents a series of episodes, and wherein the first group reference indicates that the first multimedia object represents an episode of the series (column 6 lines 11-44)(Table 1D).

As per claim 88, Lawler teaches the method of claim 87, wherein the first group reference specifies an episode number for the first multimedia object in the series of episodes (column 7 lines 25-35).

As per claim 89, Lawler teaches the method of claim 80, wherein the first content description includes a hierarchical structure in which the first group reference to the group is represented at the same hierarchical level as a container including content description elements (Table 1A-D)(Fig. 3A-C "value" "criterion field").

As per claim 90, Lawler teaches the method of claim 89, wherein the content description elements include an element describing a genre for the first multimedia object (Table 1a-d "genre")

As per claim 91, Lawler teaches the method of claim 89, wherein the content description elements include an element specifying a director, an actor, or an actress for the first multimedia object (Table 1a "Criterion field" "director" "George Lucas")

As per claim 92, Lawler teaches the method of claim 89, wherein the content description elements include an element for a textual description of the content in the first multimedia object (Table 1c "Talk" i.e. talk show).

As per claim 94, Lawler teaches the method of claim 80, wherein the first group description specifies a genre for the first group of multimedia objects (Table 1b-d "genre" & Table 2 "genre" criterion").

As per claim 95, Lawler teaches the method of claim 80, wherein the first group description specifies a director or one or more actors or actresses for the first group of multimedia objects (Table 1a "director name" for movie criteria)

As per claim 96, Lawler teaches a computer program product, embodied in a computer readable medium, for processing information related to a consumption of multimedia content, the computer program comprising instructions to cause data processing apparatus to perform operations (column 11 lines 21-28, claim 3) comprising:

-receiving one or more group descriptions ("personal preference" or "household preference" or "national preference" or "critics preference") *from a server about digital broadcast* (column 3 lines 24-31, column 11 lines 3-31), each of the one or more group descriptions describing actual content elements common in each member a respective group of multimedia objects ("Kung Fu: The legend continues" or "Trailside: Make you" or "My fair lady" or "star wars"), and including a title for the respective group and a group identifier (table 1a "movie criteria" or "sports criteria") that is a distinct element of the group description and identifies the respective group of multimedia objects (television series "MASH" Table 1c) (column 6 lines 36-42) (Fig. 3A-C)(column 4 lines 43-57)(column 5 lines 20-51)

-storing the group identifier and at least a portion of each of the one or more group descriptions in the apparatus (column 7 lines 58-67)(column 8 lines 1-3, lines 34-44)(Table 2) ;

-receiving a first content description and a first group description from the server, the first content description describing content in a first multimedia object and including (i) a title for the first multimedia object (Table 1a, "director"), (ii) a first object identifier that identifies the first multimedia object (Table 1a "George Lucas"), and (iii) a first group reference that includes a first group identifier to identify a first group of multimedia objects to which the first multimedia object belongs (Table 1a "movie criteria"), wherein the first group description describes actual content elements common in each member of the first group of multimedia objects and includes at least a title for the first group of multimedia objects (column 6 lines 10-67)(column 7 lines 1-34);

-comparing the first group identifier with the group identifier of each respective group of the one or more previously stored group descriptions if the first multimedia object is displayed on a display terminal of the apparatus (column 7 lines 35-61); and

-if the first group identifier is different from the previously stored group identifiers, storing in the apparatus the first group identifier and at least a portion of the first group description about actual content elements common in each member of the first group of multimedia objects (column 8 lines 51-67)(column 9 lines 1-10).

As per claims 97-98, 99, 102-107, 109-110 respectively, teaches same limitation as claims 81-82,84, 87-92, 94-95 respectively, therefore rejected under same basis.

As per claim 111, Lawler teaches a system for processing information related to consumption of multimedia content, the system comprising:

-a display terminal (Fig. 1 element 16);

-a memory unit (Fig. 2 element 68); and

-data processing apparatus configured to:

-receive one or more group descriptions ("personal preference" or "household preference" or "national preference" or "critics preference") ***from a server about digital broadcast*** (column 3 lines 24-31, column 11 lines 3-31), each of the one or more group descriptions describing content elements common in a respective group of multimedia objects ("Kung Fu: The legend continues" or "Trailside: Make you" or "My fair lady" or "star wars"), and including a title for the respective group and a group identifier (table 1a "movie criteria" or "sports criteria") that is a distinct element of the group description and identifies the respective group of multimedia objects (television series "MASH" Table 1c) (column 6 lines 36-42) (Fig. 3A-C)(column 4 lines 43-57)(column 5 lines 20-51)

-store the group identifier and at least a portion of each of the one or more group descriptions in the apparatus (column 7 lines 58-67)(column 8 lines 1-3, lines 34-44)(Table 2) ;

-receive a first content description and a first group description from the server (column 3 lines 24-31, column 11 lines 3-31, the first content description describing content in a first multimedia object and including (i) a title for the first multimedia object (Table 1a, "director"), (ii) a first object identifier that identifies the first multimedia object (Table 1a "George Lucas"), and (iii) a first group reference that includes a first group

identifier to identify a first group of multimedia objects to which the first multimedia

object belongs (Table 1a "movie criteria"), wherein the first group description describes

actual content elements common in each member of the first group of multimedia

objects and includes at least a title for the first group of multimedia objects (column 6

lines 10-67)(column 7 lines 1-34);

     -compare the first group identifier with the group identifier of each respective

group of the one or more previously stored group descriptions if the first multimedia

object is displayed on a terminal of the apparatus (column 7 lines 35-61); and

     -if the first group identifier is different from the previously stored group identifiers,

storing in the apparatus the first group identifier and at least a portion of the first group

description about content elements common in each member of the first group of

multimedia objects (column 8 lines 51-67)(column 9 lines 1-10).

     As per claims 112-113,114, 117-122, 124-125 respectively, teaches same

limitation as claims 81-82, 84, 87-92, 94-95 respectively, therefore rejected under same

basis.

Response to Arguments

     Applicant's arguments filed 6/16/2008 have been fully considered but they are

not persuasive.

     As per remarks, Applicant stated the following:

     A). Applicant states Lawler fails to disclose "receiving the claimed group

descriptions from a server about digital broadcast" and "storing at least a portion of

those group descriptions in the apparatus".

As per remark A, Examiner respectfully disagrees with the applicant because in column 3 lines 24-31, and column 11 lines 3-31, Lawler teaches receiving the group descriptions from a server about digital information i.e. broadcast to the multiple view station from the central node. Examiner would like to point to Fig.1 in which the central node contains multiple servers. The server sends the group description including the programming over the a network to multiple viewer stations (column 3 lines 24-31 including digital information (column 3 lines 39-52) Therefore Lawler does teach receiving group description from a server about digital broadcast.

In column 5 lines 32-40, column 7 lines 54-67, column 8 lines 1-46, including Table 2, shows that group description are stored in the central node i.e. part of the apparatus particularly states in column 7 lines 57-62, states the viewer preference table for the viewer is stored in the central node. The view preference table includes common elements in the group description i.e. name of the actor including "Tim Allen" and has count value of 27 which means the programs the view has received with the values and the characteristics of the program and a count for each value of the received programs matching the value e.g. name. This means the common element/values in this case the name of the actor which is matching in each of group descriptions of the program (multimedia objects). In this case there 27 programs (objects) for the viewer which includes "Tim Allen" which is common in the program (multimedia objects). Another way/scenario is that Table 1a, table 1c, table 1d, in this case each of the table the common element/value is described in column 6 lines 35-44. As for Table 1a the common element is movie criteria i.e. programming characteristics for the movie stars.

Therefore all the elements listed in Table 1a includes common elements i.e. it is about star wars. Same can be said about Table 1b, i.e. it is about sports criteria particularly baseball game between Toronto and Boston red sox. Therefore all the elements listed in Table 1b is sports criteria i.e. programming characteristics for Toronto and red sox game. They are the common elements in each member of the respective multimedia objects for the group descriptions. Therefore Lawler teaches the claimed limitations about "storing at least a portion of those group descriptions in the apparatus" and "elements common in each member of the first group of multimedia objects".

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A). "Method for increasing the functionality of a media player/recorder device or an application program" by Cox et al. U.S. Patent # 6,456,725.

4. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the applicant (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhairya A. Patel whose telephone number is 571-272-5809. The examiner can normally be reached on 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAP

/Ashok B. Patel/

Primary Examiner, Art Unit 2154